



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/329,182

06/10/1999

GREGORY A. LECLAIR

07426.0001-0

7787

20178

7590

01/24/2005

EPSON RESEARCH AND DEVELOPMENT INC
INTELLECTUAL PROPERTY DEPT
150 RIVER OAKS PARKWAY, SUITE 225
SAN JOSE, CA 95134

EXAMINER

NGUYEN, THU HA T

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/329,182	Applicant(s) LECLAIR ET AL.	
	Examiner Thu Ha T. Nguyen	Art Unit 2155	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED on 12/14/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachement.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1,3-5,7,8,13,14 and 19-48.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attached to Advisory Action

1. Applicant's arguments filed December 14, 2004 have been fully considered but they are not persuasive because of the following reasons:

2. In the previous telephone interview with Applicant's representative Mr. Haro, Rosalio (Reg. No. 42,633) on November 24, 2004, the Examiner explained that there is just a minor typographical error in the cover sheet of the Office Action Summary and agreed to send a supplemental office action summary to indicate and make clear the record that the action actually is final. Examiner also explained that since this matter is just a typographical error so that the supplemental office action summary will not reset the three (3) months of statutory period from the previous mailing date of the final action. And also the most current telephone interview between the Examiner, the examiner's supervisor Mr. Hosain T. Alam, Mr. Haro and his supervisor on January 19, 2004, we also reach to the agreement that the mailing date of final action will not be reset and actually is the date of the previous mailing of the final action that is September 22, 2004.

3. The reason why Examiner made the action final is because the Examiner believes that the prior arts still teach or suggest the subject matter broadly recited in the claim language. Furthermore, in response to Applicants argue that the Examiner did not do substantive search on the status of the claims. Examiner clarifies that the Examiner did update search and file relevant prior arts in the record of both the previous filed Non-final office action (March 04, 2004) and the Final action (September 22, 2004).

4. After the Office action sent out on March 4, 2004 (paper 29), the Applicants' representative contacted Examiner by telephone interview to discuss about the rejection under 112, 1st paragraph matter that was raised on paper 29 (March 4, 2004). During the telephone interview, Applicants' representative explained that "a destination address" recited in the claimed language "...said destination device send information to said input device to identify a destination address for a remote storage device" is a address of a remote storage device. Examiner explained that because the claimed language is broad so that Examiner could give a broad and reasonable interpretation as the destination device sends information to identify a destination address of that destination device to said input device. Thus, Applicants' representative agreed to amend the claim to make clear that the "destination address" is an address of a remote storage device. It is not a destination address of the destination device (see interview summary of May 18, 2004).

5. Applicants argue that Examiner ignored and overlooked limitation recited in the preamble of claim 1, that is "said destination is external and separate from said input device". In response to Applicants' argument, Examiner asserts that Examiner has pointed out in Office action that Unno does teach a destination device (i.e., a web client, web browser) is external and separate from said input device (input device 1001) as shown in figures 1, 13, col. 10, lines 50-56, col. 13 lines 58-col. 14 lines 39. Moreover, in response to applicant's arguments, the recitation "a network including a destination device and an input device, wherein said destination device is external and separate from said input device" has not been given patentable weight because the

Art Unit: 2155

recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Applicant argues that Unno does not teach the file format (i.e. jpeg, bitmap, etc.). In response to Applicant's argument, examiner asserts that Unno does teach file format or, in other word, Unno teaches converting file/data into a format that allowed to be transmitted in relation to the respective destination as shown in col. 6, lines 28-43, col. 10, lines 40-49, col. 14, lines 21-39.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (571) 272-3989. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached at (571) 272-3978.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax number for art unit 2155 is (703) 872-9306.

Thu Ha Nguyen

January 20, 2005



VIET D. VU
PRIMARY EXAMINER